

## **REMARKS**

Claims 1-42 are pending in this application. Claims 11, 20, and 39 have been amended to correct typographical errors. Claims 30 and 31 have been allowed, and claims 21, 41, and 42 have been identified as allowable if rewritten in independent form.

### **I. Rejections Under §103:**

The Office Action rejected independent claims 1, 11, 23, 32, 38, and 39 under 35 U.S.C. 103(a) as being unpatentable over Lennon et al. ('373) in view of Payne ('587). The Office Action states that Lennon et al. shows a standard ferrule connection and Payne teaches a visual indication mark that is imperceptible when proper connection at a joint is achieved. The Office Action concludes that it would have been obvious to combine the teachings of Lennon et al. and Payne to teach the claimed invention. For the following reasons, Applicants respectfully disagree.

Applicants respectfully assert that the Office Action has not established *prima facie* obviousness based on the Lennon and Payne references, as there has been no showing of a motivation to combine the two references. To establish a *prima facie* case of obviousness, there must be some reason, suggestion, or motivation, found in the prior art whereby a person of ordinary skill in the field of the invention would make the combination. MPEP § 2143, *In Re Oetiker*, 977 (Fed. Cir. 1993). *Prima facie* obviousness can only be established when motivation to combine is found explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art. MPEP § 2143.01. "The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art." MPEP § 2143.01, *In re Kotzab*, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000). See also *In re Lee*, 61 USPQ2d 1430, 1433-1434 (Fed. Cir. 2002) (discussing the importance of relying on objective evidence and making specific factual findings with respect to the motivation to combine references).

Lennon shows a suitable threaded ferrule type connection, but does not include an intrinsic gauging feature. In contrast, Payne is a push-to-connect type fitting and further does not

teach or suggest a visible intrinsic gauging feature. As such, the same mechanics are not used to determine proper pull-up. Typically, a push-t -connect fitting is either connected or not connected as indicated by a positive stop. A threaded coupling, on the other hand, is typically pulled up based on a number of turns. If the assembled initial position were nothing more than a positive stop, as in the case of the Payne reference, there would be no need to gauge the fitting. Payne does not suggest a visual gauging feature because Payne does not need a visual gauging feature.

The Payne device is assembled to a position such that the terminal edge 11 is in substantial abutment to the shoulder 6 (col. 3, lines 40-44). This acts as a positive stop during assembly. There is no visible confirmation of this condition. Payne additionally refers to use of the rib 10 for distributing plastic sealing material during assembly of the joint and for centering pipe 2 with respect to pipe 20 (see Payne, col. 2, lines 30-38, col. 3, lines 4-16). Nowhere in Payne is there a suggestion that the rib 10 may be used as a visual indication mark. Payne does not refer to the rib becoming imperceptible upon proper assembly, and the drawings of Payne show the sealing material 12 covering the rib 10 before (Fig. 2), during (Fig. 3), and after (Fig. 4) assembly of the pipe connection, suggesting that the rib not only does not provide visual indication, but that it may not even be visible.

The Office Action does not set forth any proper motivation to combine the Lennon and Payne references. Instead, the Office Action pre-supposes the problem being solved; that is, an intrinsic gauge for a threaded fitting in which a visually perceptible marking becomes substantially imperceptible when the fitting has been assembled to a pull-up position. Prior to the present application, threaded fittings were gauged using turn counts (see Lennon, col. 9, lines 5-12) or a gap inspection gauge (see, e.g., U.S. Pat. No. 3,287,813, to Lennon et al.). Applicants alone teach the advantages and benefits of including a visually perceptible marking on a threaded fitting to provide intrinsic gauging. Since there is no suggestion in the art of record as to the benefits of incorporating intrinsic gauging into a threaded fitting, such a combination can only be made by applying hindsight based on Applicants' own disclosure.

At most, the combination of the teachings of Lennon and Payne would only suggest providing Lennon with a positive stop or a rib for distributing sealing material, both of which are

inconsistent with the operation of the threaded fitting of Lennon. Further, the Office Action's conclusory statement that "'witness' marks are common in all types of joints as further confirmed by the additional teaching reference of Petersen" (*Response to Arguments, Office Action*, p. 4) provides no motivation to include such a "witness mark" on a threaded tube fitting. Petersen discloses the use of a witness portion 36 on a "push-in-and-snap connection" to "provide ready confirmation that the pipe has been inserted properly" (see col. 4, lines 28-32, col. 6, lines 21-26). As with the pipe joint connection in Payne, the push-in-and-snap connection of Petersen is inconsistent with the threaded fitting of Lennon. Therefore, Petersen also does not disclose or suggest the use of a witness portion on a ferrule type tube fitting for visual indication of fitting pull-up.

*Prima facie* obviousness has not been established, because the Office Action has not identified any motivation to combine the cited references, let alone any source in the prior art for such a motivation to combine. MPEP 2143.01. Therefore, claims 1, 11, 23, 32, 38, and 39 are patentable over these references. Further, claims 2-10, 12-22, 24-29, 33-37, and 40-42 are also patentable over the above cited references, as they are all dependant claims based on independent claims 1, 11, 23, 32, 38, and 39.

In addition to the lack of motivation to combine the cited references, as discussed above, independent claim 11 is also non-obvious in light of the Lennon and Payne references because it includes features not shown or suggested in either reference or by a combination of the references. For example, no combination of Lennon and Payne discloses a fitting with a visually perceptible marking on a threaded coupling nut including a first demarcation corresponding to an initial pull-up position and a second demarcation corresponding to a maximum pull-up position. As such, claim 11 is patentable over these references. Further, claims 12-22 are also patentable over the cited references for at least the above reasons, as they are dependant claims based on independent claim 11.

In addition to the lack of motivation to combine the cited references, as discussed above, independent claim 23 is also non-obvious in light of the Lennon and Payne references, as it includes features not shown or suggested in either reference. For example, no combination of Lennon and Payne discloses a fitting with a threaded stud member that includes intrinsic gauging

means to indicate when the threaded stud member is properly pulled up. As such, claim 23 is patentable over these references. Further, claims 24-29 are also patentable over the cited references for at least the above reasons, as they are dependant claims based on independent claim 23.

Claims 30 and 31 were identified as allowed.

In addition to the lack of motivation to combine the cited references, as discussed above, independent claim 32 is also non-obvious in light of the Lennon and Payne references, as it includes features not shown or suggested in either reference. For example, no combination of Lennon and Payne discloses a fitting having a coupling body with a visually perceptible marking that includes a lubricant, where the marking is visible when the fitting is in a finger tight condition and substantially imperceptible after the fitting has been assembled on a tube end to an initial pull-up position. If the Office Action is implying that the sealing material 12 of Payne is a marking comprising a lubricant, it should be noted that a portion of the sealing material 12 remains visible after assembly (see Fig. 4). As such, claim 32 is patentable over these references. Further, claims 33-37 are also patentable over the cited references for at least the above reasons, as they are dependant claims based on independent claims 32.

In addition to the lack of motivation to combine the cited references, as discussed above, independent claim 38 is also non-obvious in light of the Lennon and Payne references, as it includes features not shown or suggested in either reference. For example, no combination of Lennon and Payne discloses a method for gauging proper pull-up of a coupling nut on a coupling body in a ferrule type fitting that includes forming a visually perceptible mark with lubricant on the coupling body to correspond to a predetermined axial displacement of the coupling nut relative to the coupling body for initial pull-up. As such, claim 38 is patentable over these references.

In addition to the lack of motivation to combine the cited references, as discussed above, independent claim 39 is also non-obvious in light of the Lennon and Payne references, as it includes features not shown or suggested in either reference. For example, no combination of Lennon and Payne discloses a ferrule type tube fitting having a marking on a body and a marking

on a nut, where the markings are aligned in the fitting's finger tight position, become unaligned as the fitting is pulled up, and become aligned again when the fitting is fully made up. Further, claims 40-42 are also patentable over the cited references for at least the above reasons, as they are dependant claims based on independent claims 39.

A Supplemental Information Disclosure Statement is being filed concurrently with this amendment.

Applicants believe that this application is now in condition for allowance. Any questions regarding this application can be addressed to the undersigned.

Respectfully submitted,

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